

### **REMARKS**

Claims 1-16 were examined and reported in the Office Action. Claims 1-16 are rejected. Claims 3-6, 10-13 and 15 are amended. New claims 17-18 are added. Claims 1-18 remain.

Applicant requests reconsideration of the application in view of the following remarks.

#### **I. Claim Objections**

It is asserted in the Office Action that claims 3-7 and 12-14 are objected to for informalities. Applicant has amended claims 3-6 and 12 to overcome the informal Claim Objections.

Accordingly, withdrawal of the Claim Objections for claims 3-7 and 12-14 are respectfully requested.

#### **II. 35 U.S.C. § 102(b)**

It is asserted in the Office Action that claims 15-16 are rejected under 35 U.S.C. § 102(b), as being anticipated by U. S. Patent No. 6,675,008 issued to Paik et al ("Paik"). Applicant respectfully traverses the aforementioned rejection for the following reasons.

According to MPEP §2131,

[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' (Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). 'The identical invention must be shown in as complete detail as is contained in the ... claim.' (Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, *i.e.*, identity of terminology is not required. (In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)).

Applicant's amended claim 15 contains the limitations of

[a] mobile terminal, comprising: a radio frequency (RF) receiver for receiving data including caller information during a call; a memory unit for storing the caller information to be linked with a telephone number of a caller terminal; and a controller for controlling a mobile terminal to display the caller information when a paging signal is received.

Applicant's claimed invention relates to a mobile terminal and system for storing and displaying caller information, such as pictures, avatars or moving pictures of a calling party during a call. In Applicant's claimed invention, a caller terminal can designate a receiver terminal in order to transmit data including caller information and a phone number of the receiver terminal during a call.

Paik discloses a mobile radio communication network that transmits the caller information simultaneously when a telephone call is transmitted to a mobile terminal. Paik, however, does not teach, disclose or suggest that the receiver terminal can be designated by the caller terminal and the data, including caller information, can be transmitted to the designated receiver terminal during a call. That is, Paik does not teach, disclose or suggest "a radio frequency (RF) receiver for receiving data including caller information during a call; a memory unit for storing the caller information to be linked with a telephone number of a caller terminal; and a controller for controlling a mobile terminal to display the caller information when a paging signal is received.

Since Paik does not disclose, teach or suggest all of Applicant's amended claim 15 limitations, Applicant respectfully asserts that a *prima facie* rejection under 35 U.S.C. § 102(b) has not been adequately set forth relative to Paik. Thus, Applicant's amended claim 15 is not anticipated by Paik. Additionally, the claim that directly depends from claim 15, namely claim 16, is also not anticipated by Paik for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 102(b) rejections for claims 15-16 are respectfully requested.

III. 35 U.S.C. § 103

It is asserted in the Office Action that Claims 1-14 are rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over Statutory Invention Registration. H1714 by Partridge, III ("Partridge") in view of U.S. Patent Application No. 5,907,604 issued to Hsu ("Hsu"). Applicant respectfully traverses the aforementioned rejection for the following reasons.

According to MPEP §2142

[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Further, according to MPEP §2143.03, "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." *"All words in a claim must be considered* in judging the patentability of that claim against the prior art." (In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), emphasis added.)

Applicant's claim 1 contains the limitations of

a caller terminal for storing caller information and transmitting data including the caller information during a call; a service system for receiving the data including the caller information from the caller terminal and transmitting the data to a receiver terminal; and the receiver terminal for receiving the data from the service system, storing the caller information to be linked with a telephone number on the caller terminal, and displaying the caller information when a paging signal is received.

Applicant's claim 3 contains the limitations of

a caller terminal for transmitting data including caller information and a phone number of a designated receiver terminal during a call; a service system for temporarily storing the data received from the caller terminal and transmitting the data to the designated receiver terminal when the designated receiver terminal is in a state for receiving the caller information; and the designated receiver terminal for receiving the data from the service system, storing the caller information to be linked with a phone number of the caller terminal, and displaying the caller information when a paging signal is received.

Applicant's claim 5 contains the limitations of

a caller terminal; a service system for storing data including the caller information and phone numbers of designated receiver terminals and transmitting the caller information to the designated receiver terminal when the designated receiver terminal is in a state for receiving the caller information; and the designated receiver terminal for receiving the data from the service system, storing the caller information to be linked with a phone number of the caller terminal, and displaying the caller information when a paging signal is received.

Applicant's claim 8 contains the limitations of

at a caller terminal, storing caller information and transmitting data including the caller information to a service system during a call; at the receiver terminal, receiving the data from the service system to store the caller information to be linked with a phone number of the caller terminal; and at the receiver terminal, displaying the caller information when a paging signal is received.

Applicant's claim 10 contains the limitations of

at a caller terminal, transmitting data packets including the caller information and a phone number of a designated receiver terminal to a service system; at a service system, temporarily storing the data from the caller terminal and transmitting the data to the designated receiver terminal when the designated receiver terminal is in a state for receiving the caller information; at the designated receiver terminal,

receiving the data from the service system to store the caller information to be linked with a phone number of the caller terminal; and at the designated receiver terminal, displaying the caller information when a paging signal is received.

Applicant's claim 12 contains the limitations of

at a service system, storing data including the caller information and a phone number of a designated receiver terminal and transmitting the caller information to the designated receiver terminal when the designated receiver terminal is in a state for receiving the caller information; at the designated receiver terminal, receiving the data from the service system to store the caller information to be linked with a phone number of the designated receiver terminal; and at the designated receiver terminal, displaying the caller information when a paging signal is received.

Partridge discloses automatic still image selection and transmission upon the placement of a call to a video telephone or terminal. Hsu discloses displaying of an image in association with a telephone system Caller ID. Even if Partridge is combined with Hsu, the resulting invention would still not teach, disclose or suggest that the receiver terminal can be designated by the caller terminal and the data, including caller information, can be transmitted to the designated receiver terminal during a call. That is, neither Partridge, Hsu, and therefore, nor the combination of the three teach, disclose or suggest the limitations: in claim 1 of "a caller terminal for storing caller information and transmitting data including the caller information during a call;" in claim 3 of

a caller terminal for transmitting data including caller information and a phone number of a designated receiver terminal during a call; a service system for temporarily storing the data received from the caller terminal and transmitting the data to the designated receiver terminal when the designated receiver terminal is in a state for receiving the caller information; and the designated receiver terminal for receiving the data from the service system,

in claim 5 of

transmitting the caller information to the designated receiver terminal when the designated receiver terminal is in a state for receiving the caller information; and the designated receiver terminal for receiving the data from the service system,

in claim 8 of "storing caller information and transmitting data including the caller information to a service system during a call," in claim 10 of

transmitting the data to the designated receiver terminal when the designated receiver terminal is in a state for receiving the caller information; at the designated receiver terminal, receiving the data from the service system to store the caller information to be linked with a phone number of the caller terminal; and at the designated receiver terminal,

and in claim 12 of

storing data including the caller information and a phone number of a designated receiver terminal and transmitting the caller information to the designated receiver terminal when the designated receiver terminal is in a state for receiving the caller information; at the designated receiver terminal, receiving the data from the service system to store the caller information to be linked with a phone number of the designated receiver terminal; and at the designated receiver terminal, displaying the caller information when a paging signal is received.

Since neither Partridge, Hsu, nor the combination of the two, teach, disclose or suggest all the limitations of Applicant's claims 1, 3, 5, 8, 10 and 12, as listed above, Applicant's claims 1, 3, 5, 8, 10 and 12 are not obvious over Partridge in view of Hsu since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claims that directly or indirectly depend from amended claims 1, 3, 5, 8, 10 and 12, namely claims 2, 4, 6-7, 9, 11, and 13-14, respectively, would also not be obvious over Partridge in view of Hsu for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejections for Claims 1-14 are respectfully requested.

**CONCLUSION**

In view of the foregoing, it is submitted that claims 1-18 patentably define the subject invention over the cited references of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

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Dated: December 20, 2005

By: 

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**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail with sufficient postage in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, Virginia 22313-1450 on December 20, 2005.

  
Jean Svoboda